

## REMARKS

Claims 1-51 are pending and at issue in the application with claims 1, 4, 24, 41 and 47 being independent claims. As a result, 5 independent claims exist in the application as previously paid for, and 51 total claims exist in the application as previously paid for. The applicants believe no fee is due. However, the Commissioner is hereby authorized to charge any deficiency in the amount enclosed or any additional fees which may be required under 37 CFR 1.16 or 1.17 to Deposit Account No. 13-2855. Reconsideration and withdrawal of the rejections in view of the remarks below is respectfully requested.

### **Request to Withdraw the Holding of Finality**

As an initial matter, the applicants respectfully submit that the present action should not be made final and request that the holding of finality be withdrawn. In particular, the present action cites a new reference against claims 1-15 and 17-51. In rejecting claims 1-51 as obvious over of Loose et al. (U.S. Patent No. 6,517,433) in view of Slomiany et al. (U.S. Patent No. 6,612,927), the action attempts to establish a motivation to combine the disclosures of Loose et al. and Slomiany et al. by citing Coles et al. (U.S. Application Serial No. 09/904,061). (See present action, page 13, paragraph 18). However, in the previous action, Coles et al. was only cited in the obviousness rejection against claim 16. Accordingly, to the extent the action relies upon Coles et al. in establishing a *prima facie* case of obviousness against claims 1-15 and 17-51, Coles et al. is considered a newly cited reference with respect to claims 1-15 and 17-51. The MPEP is clear that a second or any subsequent action on the merits in any application cannot be made final "if it includes a rejection on newly cited art ... of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art." MPEP § 706.07(a).

Further, the present action introduces new grounds for rejection when none of the claims have been amended as to necessitate new grounds for rejection. It is clear that grounds for rejection includes not only the statutory basis for the rejection and the cited references, but also the factual basis for the rejection including identifying the relevant teachings of the references being relied upon. See MPEP 706.02(j) and 2142. While the present action cites Fig. 10E, column 8, lines 6-20 and column 10, lines 19-25 of Slomiany et al. (see present action, pages 10-11, paragraph 14), which were not cited in the previous action. The only other assumption would be that the previous action meant to cite the entire

disclosure of Slomiany et al., in which case the previous rejection would be considered an omnibus rejection. However, MPEP 707.07(d) clearly precludes omnibus rejections. Accordingly, the only conclusion is that the new citations to Slomiany et al. constitute new grounds for rejection.

Accordingly, the finality of the present action is improper and should be withdrawn. Such withdrawal is respectfully requested.

### **35 U.S.C. §103(a) Rejections**

The applicants respectfully traverse the rejections of claims 1-51 as unpatentable over Loose et al. in view of Slomiany et al. The applicants also traverse the rejection of claim 16 as unpatentable over Loose et al. in view of Slomiany et al. and further in view of Coles et al.

It is apparent from reviewing the Response to Arguments on pages 9-14 of the action, that the applicants' remarks in the previous response have been misunderstood and/or not fully considered. In the previous response, the applicants argued (and maintain) that the action failed to established a *prima facie* case of obviousness because 1) the action failed to address all of the claim limitations; 2) the references did not disclose all of the claim limitations; and 3) the asserted motivation to combine the references was improper.

#### *The Action Fails To Address All Of The Claim Limitations*

Both the previous and present actions fail to address all the features of independent claims 1, 4, 24, 41 and 47. MPEP 2142 requires that the burden is upon the Office to establish a *prima facie* case of obviousness by factually supporting any conclusion of obviousness. MPEP 706.02(j) requires that an action include "the relevant teachings of the prior art relied upon." In other words, it is not incumbent upon the applicant to have to guess where the references may disclose the features of the claims, but rather, it is entirely incumbent upon the Office to demonstrate how each feature of the claim is disclosed or suggested by the references. Failure to do so is a failure to establish a *prima facie* case of obviousness.

A simple review of the rejection of claims 1-51 plainly reveals that both the previous action and the present action fail to fully address all the features of independent claims 1, 4, 24, 41 and 47. In particular, the action has not demonstrated where either Loose et al. or Slomiany et al. disclose or suggest the features of preventing a second wager on a first game

type if at least a predetermined (or nonzero) value payout associated with the first game type is determined and receiving wager data representing a second wager on the first game type if reset data is received. For example, with reference to claim 1, the action appears to assert that Loose et al. discloses a value input device, a display unit, a controller coupled to the display unit, where the controller comprises a processor and a memory operatively coupled to the processor, and where the controller is programmed to cause the display unit to generate a first game display relating to a first game type. (See present action page 5, paragraph 3). The action admits that Loose et al. does not disclose, among other features, a controller programmed cause the display unit to generate a second game display relating to a second game type different from the first game type if the controller determined the first value payout to be at least a predetermined amount. (See present action page 6, paragraph 3c). The action appears to further assert that Slomiany et al. discloses a controller that causes a display unit to generate a second game display relating to a second game type different from the first game type if the controller determined a first value payout to be at least a predetermined (or nonzero) amount. (See present action, pages 6-7, paragraph 4).

However, the action does not assert, much less demonstrate, that either Loose et al. or Slomiany et al. discloses or suggests that the controller is programmed to prevent a second wager on the first game type if the controller determined a first value payout associated with the first game type to be at least a predetermined amount. This is a feature specifically recited in claim, and is not, as asserted in the present action, “limitations from the specification” being read into the claims. (See present action page 10, paragraph 14). Independent claims 4, 24, 41 and 47 recite similar features, which are also not addressed. If the action is unable to factual support its conclusion of obviousness by providing where the relevant teachings Loose et al. and Slomiany et al. disclose all of the features of independent claims 1, 4, 24, 41 and 47, then the rejection of claims 1-51 must fail.

#### *The References Do Not Disclose All Of The Claim Limitations*

Despite the failure of the action to address the feature of preventing a second wager on a first game type if at least a predetermined (or nonzero) value payout associated with the first game type is determined, neither Loose et al. nor Slomiany et al. disclose or suggest this feature. Further, neither Loose et al. nor Slomiany et al. disclose or suggest causing a second

game display to be generated if a first value payout associated with an outcome of a first game type is determined to be at least a predetermined (or nonzero) amount.

While the action asserts that “[once] this winning event is determined, the controller does not offer the player to place a bet on the first game since the controller is programmed to generate the second level (game) once the winning event is determined (Col 8 lines 6-20)”, the portions of Slomiany et al. do not support this contention. (See action page 11, paragraph 14). In particular, column 8, lines 6-20 simply reads:

Turning now to FIG. 1, the first embodiment has each stage as a five-reel, five-line video slot machine. This is of a type of slot machine often called "Australian style." This machine allows the player to make a wager on one to five paylines, and allows a bet from one to nine coins bet on each payline for a maximum of forty-five coins bet per game. FIG. 1 shows the first three paylines, with payline 1 drawn horizontally across the center symbols, payline two drawn across the upper symbols and payline three drawn across the lower symbols.

This portion of Slomiany et al. makes absolutely no mention of preventing a further wager on the first stage of the game if a winning event is determined. Although Slomiany et al. discloses advancing from one stage game to the next upon the occurrence of an advancement condition (see e.g., Abstract; column 1, line 56 to column 3, line 67), Slomiany et al. does not disclose preventing a second wager on the first stage if a predetermined (or nonzero) value payout is determined. Indeed, there is nothing that prevents the player from continuing to wager on the first stage even upon the occurrence of an advancement condition (e.g., a winning condition), other than the player's own choice and not the result of a determination from the gaming apparatus or controller.

Further, the cited portions of Slomiany et al. do not disclose causing a second game display to be generated if a first value payout associated with an outcome of a first game type is determined to be at least a predetermined (or nonzero) amount. Despite the assertions of the present action, the cited portions of Slomiany et al. do not disclose the advancement condition as being a value payout of at least a predetermined amount or nonzero amount. Instead, as acknowledged by the present action, the advancement condition is a win/lose condition. (See present action, page 11, paragraph 14). However, contrary to the assertion of the present action, a win is not well known in the art to be a value payout of a predetermined amount or nonzero amount. Instead, a win is merely an outcome (i.e., condition) of the game being played. A value payout amount may be associated with a win, but a winning condition

in and of itself is not a value payout amount. Indeed, the claims specifically recited that the value payout is associated with an outcome of the first game type. It is clear from the disclosure of Slomiany et al., and from the admissions of the present action, that the advancement condition is not dependent upon the amount of the value payout, but rather upon a win/lose condition. (See e.g., column 1, line 56 to column 2, line 57). As such, Slomiany et al. does not disclose or suggest displaying a second game if the value payout associated with an outcome of the first game type is at least a predetermined or nonzero amount, as recited by the claims.

Loose et al. also does not disclose or suggest preventing a second wager on a first game type if at least a predetermined (or nonzero) value payout associated with the first game type is determined or causing a second game display to be generated if a first value payout associated with an outcome of the first game type is determined to be at least a predetermined (or nonzero) amount for the reasons provided in response to the previous action, nor has the present action provided (or otherwise argued) Loose et al. for this purpose.

It is clear that a *prima facie* case of obviousness cannot be established where all the limitations of a claimed combination are not taught or suggested by the prior art. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). See also MPEP 2143.03. Accordingly, the action has not presented a *prima facie* case of obviousness for claims 1-51, and the rejection of claims 1-51 must fail.

*The Asserted Motivation To Combine The References Is Improper*

Although a motivation to combine references may be from the knowledge of persons of ordinary skill in the art and does not need to be expressly articulated in the cited references, is it still incumbent upon the action to identify the reason why a person of ordinary skill in the art would have combined the elements of the references in the same manner as claimed. Merely asserting that “the motivation ... comes from the well-known system lockup event that happens when the player hits a jackpot and the player has to wait several minutes of the attendant to come signal the system to allow the player to continue playing a new game of the same type of a totally different game” only states the problem and not the motivation to combine the elements of Loose et al. and Slomiany et al.

The present action cites Coles et al. as proving that the asserted motivation is well known in the art. However, to the extent the action relies upon Coles et al. as establishing a *prima facie* case of obviousness (i.e., for the purpose of establishing a motivation to combine), the present action **cannot** be made final for the reasons provided above. To the extent Coles et al. is not being cited as part of the grounds for rejection, but rather being cited as pertinent prior art, the grounds for rejection of claims 1-15 and 17-51 do not include Coles et al., and the present action's reliance upon Coles et al. cannot be given any weight. Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. See *In re Hoch*, 428 F.2d 1341, 1342, n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). See also MPEP 706.02(k). Should any subsequent action present an obviousness rejection against any of claims 1-15 and 17-51 based on Coles et al., such a rejection must be presented as new grounds of rejection or the finality of the present action must be withdrawn.

Even aside from Coles et al., the present action still does not provide any indication as to the source of the asserted motivation, whether explicitly or implicitly in the references themselves. Instead, the asserted motivation only states that the problem was well known (i.e., jackpot event lockup). To the extent the action relies upon the implicit teachings of Loose et al. or Slomiany et al., the present action still has not identified how one of ordinary skill in the art would interpret Loose et al. or Slomiany et al. so as to combine the references in the same manner as claimed. While a motivation to combine references may be found in the nature of the problem to be solved, one of ordinary skill in the art must still be motivated to combine the references to obtain the solution. For example, the motivation to combine the reference may be found in the nature of the problem to be solved if each reference is directed to the asserted problem. *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 69 USPQ2d 1686 (Fed. Cir. 2004). See also MPEP 2143.01. However, in the response to the previous action, the applicants clearly established that neither Loose et al. nor Slomiany et al. address the problem of player wait times due to a system lockup event, much less the solution for that problem as set forth in claims 1-51, and the present action does not dispute this argument.

Indeed, the action's characterization of the problem of player wait times due to a system lockup event as "well known" admits the existence of a long felt need for a solution to the problem, which is an objective evidence of a secondary consideration of nonobviousness.

See MPEP 2141(III). The applicants provided this argument in the response to the previous action, and the present action does not dispute this argument.

Accordingly, because the present action has not identified a reason why a person of ordinary skill in the art would have combined the elements of the references in the same manner as claimed, it must be concluded that the asserted motivation is derived from the disclosure of the application. (See application, page 1, lines 4-32). The action's mere assertion that "[the] motivation was in no way dubbed from the applicant (sic) disclosure" cannot be given any weight in the absence of evidence to the contrary, especially where Coles et al. is only now (presumably) being cited for the purpose of establishing the motivation. Again, the weight accorded to Coles et al. is entirely dependent upon the present action's reasons for citing Coles et al. Otherwise, the action has not presented a motivation to combine the references, and therefore has not presented a *prima facie* case of obviousness for claims 1-51, and the rejection of claims 1-51 must fail. See MPEP 2143 and 2144.

#### **Double-Patenting Rejections**

The applicants respectfully traverse the judicially created doctrine of obviousness-type double patenting rejection of claims 1-15 and 17-51 over co-pending U.S. Application Serial No. 10/178,876 ("the '876 application) in view of Slomiany et al., and the rejection of claims 4 and 16 over the '876 application in view of Slomiany et al. and further in view of Coles et al.

The applicants maintain that an obviousness-type double patenting rejection can only exist between an application and an issued patent. While the action asserts that "[it] is not required for the second reference to be an issued patent" (see action page 9), this assertion is incorrect. While a *provisional* rejection based on double patenting may be asserted between copending applications, it is clear that the obviousness-type double patenting rejection of the present action is not a *provisional* rejection. (See MPEP 804(I)(B)). Accordingly, the obviousness-type double patenting rejection of claims 1-51 is improper and must be withdrawn. Should any subsequent action present a provisional obviousness-type double patenting rejection against any of claims 1-51, such a rejection may be presented as new grounds of rejection because the present rejection is not a provisional rejection.

The applicants further maintain that the action does not make out a *prima facie* case of obviousness-type double patenting. In particular, the analysis employed in an

obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. §103 obviousness determination. However, for the reasons provided above with respect to Slomiany et al., it is clear that the action does not make out a *prima facie* case of obviousness-type double patenting because the references fail to disclose all of the limitations of claims 1-51, and the action provides an insufficient motivation to combine or modify the references.

### **Conclusion**

For the foregoing reasons, reconsideration and withdrawal of the rejections of the claims and allowance thereof are respectfully requested. Should the examiner wish to discuss the foregoing, or any matter of form, in an effort to advance this application towards allowance, the examiner is urged to telephone the undersigned at the indicated number.

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